

UTILITY PATENT

ATTORNEY DOCKET NO. VCR1175

REMARKS**The Claimed Invention**

The claimed invention is directed to a boot dryer device, an associated kit for assembling the boot dryer device and a method of using same are disclosed for use in conveniently drying a pair of wet boots.

The Pending Claims

Prior to entry of the above amendments, Claims 1-20 are pending. Claims 1-14 are directed to a boot dryer device. Claims 15-19 are directed to an associated kit for assembling the boot dryer device. Claim 20 is directed to a method of using a kit for assembling a boot dryer device for air drying a pair of wet shoes.

The Office Action

Claims 1, 3, 15, and 17 stand rejected under 35 U.S.C. § 102(b) as anticipated over Barker et al. (US 5,222,308).

Claims 2, 4-14, 16, and 18-19 stand rejected under 35 U.S.C. § 103(a) as obvious over Barker in view of Rice (US 5,720,108).

Claim 20 stands rejected under 35 U.S.C. § 103(a) as obvious over Sloan (US 5,289,642) in view of Rice.

RESPONSE TO SPECIFIC OBJECTIONS AND REJECTIONS

The Examiner's specific objections and rejections are reiterated below as small indented bold print, followed by Applicants' response in normal print.

REJECTION UNDER 35 U.S.C. §102

Claims 1, 3, 15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Barker et al. (US 5,222,308). Barker is considered to disclose a device comprising:

a T-junction conduit 17 having an input port and two outlet vent ports, said input port of said I-junction conduit in fluid communications with said two outlet vent ports; and an adaptor sleeve 12 attached to said T-junction conduit, said adaptor sleeve having an entrance port and an exit port said entrance port of said adaptor sleeve in fluid communications with said exit port of said adaptor sleeve, said exit port of said adaptor sleeve in fluid communications with said input port of said T-junction conduit. Barker is also considered to disclose an electric air dryer 15 attached to said entrance port of said adaptor sleeve, said electric air dryer having an electric power cord, an air intake vent, and an air output vent, said air intake vent in fluid communications with said air output vent, said air output vent in fluid communications with said entrance port of said adaptor sleeve.

The applicant has subsequently cancelled claims 1, 3, 15, and 17 without prejudice. Accordingly, the applicant has removed the basis for this rejection of claims 1, 3, 15, and 17. Therefore, this rejection of claims 1, 3, 15, and 17 should be withdrawn.

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FIRST REJECTION UNDER 35 U.S.C. §103(a)

Claims 2, 4-14, 16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker in view of Rice (US 5,720,108). Barker is considered to disclose the claimed invention, as discussed above under the anticipatory rejection, except for the claimed air divider wedge, elastic, and plastic or fabric material. Rice is considered to disclose an air divider wedge at column 5 lines 64-67. It would have been obvious to one skilled in the art to combine the teachings of Barker with the air divider wedge considered to be taught by Rice for the purpose of diverting drying air flow for moist boots. Furthermore Barker in view of Rice is considered to disclose the claimed invention except for the claimed elastic, and plastic or fabric material. It would have been an obvious matter of design choice to provide the teachings of Barker in view of Rice with the material claimed by the applicant, since applicant has not patentably distinguished the material advantages over the materials found in the prior art.

The applicant has subsequently cancelled claims 2, 4-14, 16, and 18-19 without prejudice. Accordingly, the applicant has removed the basis for this rejection of claims 2, 4-14, 16, and 18-19. Therefore, this rejection of claims 2, 4-14, 16, and 18-19 should be withdrawn.

SECOND REJECTION UNDER 35 U.S.C. §103(a)

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sloan (US 5,289,642) in view of Rice. Sloan is considered to disclose a method comprising:

obtaining the kit comprising:

a T-junction conduit 16 having an input port and two outlet vent ports, the input port of the T-junction conduit in fluid communications with the two outlet vent ports; and

an adaptor sleeve 20 attachable to the T-junction conduit, the adaptor sleeve having an entrance port and an exit port the entrance port of the adaptor sleeve in fluid communications with the exit port of the adaptor sleeve, the exit port of the adaptor sleeve capable of being configured in fluid communications with the input port of the T-junction conduit;

an electric air dryer 14 attachable to the entrance port of the adaptor sleeve, the electric air dryer having an electric power cord, an air intake vent, and an air output vent, the air intake vent in fluid communications with the air output vent, the air output vent capable of being configured in fluid communications with the entrance port of the adaptor sleeve;

plugging the electric power cord of the electric air dryer to an electric power socket; switching on the electric air dryer;

hanging a pair of wet boots on the two outlet vent ports of the T-junction conduit while the electric air dryer is switched on;

removing the hung boots from the two outlet vent port of the T-junction conduit when the hung boots become dry;

turning off the electric air dryer;

unplugging the electric power cord of the electric air dryer from the electric power socket;

slipping off the second elastic band of the exit port of the adaptor sleeve from around the input port of the T-junction conduit; and

pulling off the first elastic band of the entrance port of the adaptor sleeve around the air output vent of the electric air dryer (please see column 2 line 7 through column 4 line 68 for the operational steps involved, which are considered to anticipated the claimed steps). Sloan is considered to disclose the claimed invention, as discussed above under the anticipatory rejection, except for the claimed air divider wedge, elastic, and plastic or fabric material. Rice is considered to disclose an air divider wedge at column 5 lines 64-67. It would

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have been obvious to one skilled in the art to combine the teachings of Sloan with the air divider wedge considered to be taught by Rice for the purpose of diverting drying air flow for moist boots. Furthermore Sloan in view of Rice is considered disclose the claimed invention except for the claimed elastic. It would have been an obvious matter of design choice to provide the teachings of Sloan in view of Rice with the material claimed by the applicant, since applicant has not patentably distinguished the material advantages over the materials found in the prior art.

Regarding claim 20, the applicant respectfully traverses this rejection because a *prima facie* case of obviousness has not been presented.

It is by now well settled that the burden of establishing a *prima facie* case of obviousness resides with the Patent and Trademark Office (hereinafter referred to as USPTO). The USPTO bears the burden of establishing a *prima facie* case of obviousness.¹ Only if this burden is met does the burden of coming forward with rebuttal argument or evidence shift to the Applicant.² When the references cited by the USPTO fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned.

The test of obviousness *vel non* is statutory. It require that one compare the claim's "subject matter as a whole" with the prior art "to which said subject matter pertains."³ The inquiry is thus highly fact-specific by design. This is so "whether the invention be a process for making or a process of using, or some other process."⁴ When the references cited by the USPTO fail to establish a *prima facie* case of obviousness, the rejection is improper and should be overturned.

In review of this rejection, the Applicant respectfully points out that the USPTO has failed to apply the proper test for obviousness established by *Graham v John Deer Co.* and its progeny.⁵ That is, the USPTO failed to weigh the specific differences between the claimed invention with all its limitations and the prior art references, the so-called "second Graham factor."⁶

First, by applying this statutory test of obviousness to the present rejection, the applicant can find no specific citation used by the USPTO which specifically teaches, suggests or motives ALL of the presently claimed step elements found in claim 20. The applicant respectfully points out that the USPTO appears to have ignored or overlooked the requisite steps of (1) wrapping and (2) enveloping required within the present method invention. Since this rejection is based on an incomplete itemization of the ALL of the requisite claimed steps of the present invention, then a *prima facie* of obviousness was not established by the USPTO. Accordingly, the

¹ In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed.Cir.1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir.1992).

² In re Rijckaert, 9 F.3d at 1532, 28 USPQ2d at 1956.

³ 35 U.S.C. § 103

⁴ In re Kuehl, 475 F.2d 656, 177 USPQ 250, 255 (CCPA 1973)

⁵ Graham v John Deer Co., 383 U.S. 1, 148 USPQ 459 (1966).

⁶ Id. 383 U.S. at 17 stating "Under § 103 . . . differences between the prior art and the claims at issue are to be ascertained[.]"

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applicant respectfully submits that for this reason alone, this rejection of method claim 20 under 35 U.S.C. §103(a) should be withdrawn.

Second, the applicant can find no specific citation used by the USPTO which specifically teaches, suggests or motivates any of the presently claimed step elements found in claim 20. Even though the cited references teach the generic art of a boot drying devices, the USPTO has apparently ignored this statutory test in assessing the obviousness of each of the method steps found in claims 20 by arbitrarily evoking that the "Sloan is considered to disclose the claimed invention, as discussed above under the anticipatory rejection, except for the claimed air divider wedge, elastic, and plastic or fabric material." (See this Office Action page 5, lines 14-16). After careful review of the Sloan reference, the applicant remains unable to locate ANY specific location within the Sloan or Rice references which teach, disclose or motivate ANY of the presently claimed method steps as alleged by the USPTO. Therefore, the applicant respectfully requests that the USPTO provide specific citations where and how exactly the Sloan reference teaches the alleged steps of: (1) obtaining, (2) plugging, (3) switching, (4) hanging, (5) removing, (6) turning, (7) unplugging, (8) slipping, and (9) pulling. Therefore, for this reason alone, a *prima facie* of obviousness was not established. Accordingly, the Applicant respectfully submits that this rejection of method claim 20 under 35 U.S.C. §103(a) should be withdrawn.

Third, even if the USPTO allegations the Sloan and Rice references are somehow construed to have actually teach the various presently claimed methods, the applicant respectfully argues that the USPTO has failed to establish a *prima facie* of obviousness because the USPTO has not presented any assertion that these cited references could somehow teach the specific ordering of the presently claimed method steps. The applicant respectfully points out that "[t]he mere fact that a device or process utilizes a known scientific principle does not alone make that device or process obvious."⁷ For instance, the applicant respectfully points out that the hanging step of the present invention is required to be performed while the electric air dryer is switched on. Another example of the requisite method step ordering is that the slipping step must be performed subsequent of the enveloping step. Likewise, the present method invention requires that the pulling step is to be performed only after the wrapping step. Therefore, for this reason alone, a *prima facie* of obviousness was not established. Accordingly, the Applicant respectfully submits that this rejection of method claim 20 under 35 U.S.C. §103(a) should be withdrawn.

The Applicant gratefully appreciates the Examiner's efforts in reviewing the patentability of the present invention.

⁷ Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1053, 5 USPQ2d 1434, 1400 (Fed. Cir. 1988). See also Lindeman Maschinenfabrik GmbH v American Hoist & Derrick Co., 730 F2d 1452, 1462, 221 USPQ 481, 489 (Fed. Cir. 1984).

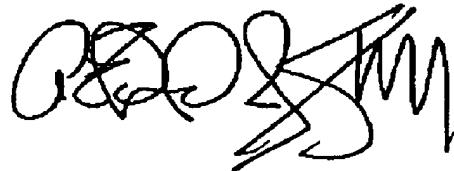
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CONCLUSION

In view of the above amendment and remarks, it is submitted that this application is now ready for allowance. Accordingly, reconsideration and reexamination are respectfully requested in view of the above amendments and remarks. Early notice to that effect is solicited. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (512) 306-0321.

Respectfully submitted,



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Date: October 12, 2004

Certificate of Facsimile

I hereby certify that this correspondence is being transmitted by fax to the United States Patent and Trademark Office on the date shown below.

Anthony Edw. J Campbell



Tuesday, October 12, 2004